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09/905,679	07/13/2001	Don Wilson JR.	032781-011	4812

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EXAMINER

ROBERTS, PAUL A

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 08/13/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/905,679

Applicant(s)

WILSON ET AL.

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/27/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-24 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that examining the applicant's two patentably distinct inventions is not burdensome to the examiner. This is not found persuasive because although some of the subclasses between the searches for each invention overlap, not all of subclasses overlap, and thus a distinct search will be required for each invention. Additionally, distinct text searches will be required for all of the devices. The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to because figure 22 has labels that disagree with the following text "[0067] FIG. 24 depicts the jaw assembly in a closed configuration. As described above in connection with FIGS. 12-14, when collar 34 is advanced, cams 38a-38d impinge on the cam surfaces 214a, 214b, 224a, 224b, which closes the jaw assembly. Collar 34 includes slots 35a-35d that allow the rear portions of jaw legs 212, 222 to extend outwardly so that the jaws can close." There are no items labeled 212 or 222 in this figure. This type of error has been made frequently made throughout the application. The applicant is required to correct all the elements mentioned in the specification that don't have corresponding labels in the figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of claim 20 is ambiguous because it not apparent whether 'the yoke that is connected to the trigger and the outer shaft is slideably movable' or 'the yoke connected to the trigger and the outer shaft wherein said shaft is slideably movable'. Please amend this claim, so the claim's meets and bounds of this claim are understood. The examiner is assuming the latter was the applicant's intended interpretation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by McGarry et al. 4509518. For the purpose of simplicity, all references that contain multiple inventors (for example Smith et al.) will be referenced by only the first inventor (Smith). The full name of the inventive identity will be disclosed the first time the reference is cited, and abbreviated in the above manner thereafter. McGarry discloses the following:

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5. Regarding claim 1, an endoscopic surgical clip applier (10), comprising: a shaft assembly (22) having a distal end (110) adapted for insertion through a cannula into a body cavity (device is inherently capable of this feature); a clip channel (78) disposed within the shaft (78) assembly for retaining a plurality of clips; a jaw assembly (12) extending from the distal end of the shaft assembly and comprising: a first jaw member having a first jaw arm for engaging a first portion of a ligating clip and an opposing second jaw arm for engaging a second portion of a ligating clip, the first and second jaw arms each comprising a cam surface, and a second jaw member having a third jaw arm for engaging a third portion of a ligating clip and an opposing fourth jaw arm for engaging a fourth portion of a ligating clip, the third and fourth jaw arms each comprising a cam surface; and an actuation assembly (102) for advancing a clip from the clip channel to the jaw assembly and closing the jaw assembly. The McGarry device has this same jaw structure because there are two jaw plates (analogous to the applicant's jaw arm) per jaw member. Each jaw plate engages a different section of the clip. All jaw arms are attached to a cam surface (52).

6. Regarding claim 2, the shaft assembly (22 and 58) includes: an outer shaft member (22) having a longitudinal axis extending along its length; a clip channel (78) disposed within the shaft member and moveable relative to the outer shaft along the longitudinal axis.

7. Regarding claims 3-10, figure 2 shows the U-shaped bridge members each with two sets of legs. The bridge member is connected to the jaw member and is pivotably connected to the clip channel. The bridge member is pivotably connected because one can pivot the bridge member relative to clip channel when the device is actuated. The outer shaft has cam surfaces, which engage the jaw cam surfaces. The actuation assembly induces relative motion between

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the clip channel and the shaft. The shaft moves relative to the clip channel. Item 110 is the clip feeding assembly.

8. Regarding claim 11, a feeder bar (92) slideably moveable along a length of the clip channel (58), the feeder bar having a plurality of clip advancing elements (the ratchet teeth) for advancing clips toward the distal end of the clip channel is disclosed.

9. Regarding claim 12, the feeder bar is moveable between a proximal position, in which the clip feeding mechanism retrieves a clip from the clip channel, and a distal position, in which the feeder bar delivers a clip to the jaw assembly (see column 7, 42-40).

10. Regarding claim 13, the feeder bar includes a foot member (96) for rotating the most distal clip in the clip cartridge when the feeder bar moves in a proximal direction.

11. Regarding claim 14, an endoscopic surgical clip applier, comprising: an exterior shaft assembly having a proximal end and a distal end adapted for insertion through a cannula (McGarry device is inherently capable of being inserted into a cannula) into a body cavity and having a plurality of cam surfaces formed at the distal end; a jaw assembly extending from the distal end of the shaft assembly and including a first jaw member having a first jaw arm for engaging a first portion of a ligating clip and an opposing second jaw arm for engaging a second portion of a ligating clip, the first and second jaw arms each comprising a cam surface (the McGarry device has a jaw member which includes the cam assembly (86) for the jaw (12)); a clip channel disposed within the exterior shaft assembly and adapted to hold a plurality of clips; a feeder bar for feeding clips from the clip channel to the jaw assembly; and an actuation assembly for closing the jaw assembly, wherein the actuation assembly induces relative motion

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between the exterior shaft assembly and the jaw assembly so that contact between the cam surfaces closes the jaw assembly.

12. Regarding claims 15, 16, and 17 the jaw assembly includes a second jaw member having a third jaw arm for engaging a third portion of a ligating clip and an opposing fourth jaw arm for engaging a fourth portion of a ligating clip, the third and fourth jaw arms each comprising a cam surface.

13. Regarding claim 18, a feeder bar slideably moveable along a length of the clip channel, the feeder bar having a plurality of clip advancing elements for advancing clips toward the distal end of the clip channel; and an actuating assembly for actuating the feeder bar.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarry '518 in view of Cuny et al 5772673. Regarding claims 19-21, the actuation assembly for closing the jaw assembly includes: a handle assembly (18). The assembly doesn't include a trigger or a ratcheting mechanism. The assembly doesn't include a yoke connected to the trigger and the outer shaft, *wherein the shaft is* slideably moveable such that depressing the trigger moves the exterior shaft relative to the jaw assembly. Cuny discloses an endoscopic stapler that has a trigger 14 with a ratcheting mechanism (fig 40). The yoke (152) is connected to the trigger. At

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the time of the invention it would have been obvious to one having ordinary skill in the art to attach the Cuny trigger mechanism to the McGarry device to facilitate closing of the device. The Cuny device uses a yoke to drive the ratchet. It would have been obvious to attach a yoke and ratchet to the McGarry device to eliminate the strain realized by the operator when the clip appliers are held in a half crimped position. Depressing the trigger would inherently move the McGarry shaft relative to the jaw assembly and the feeder bar relative to the clip channel because the trigger would function the same as the McGarry actuation mechanism. The McGarry reference discloses both of these two features.

15. Regarding claims 22-24, the clip exterior shaft includes a collar (22) having a plurality of cam surfaces formed at the distal end (86). The actuation assembly induces relative motion between a feeder bar and the clip channel to advance a clip from the clip channel into the jaw assembly. The actuation assembly induces relative motion between the exterior shaft assembly and the clip channel to close the jaw assembly.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Montgomery et al.	4662373	Surgical Ligator
Peyser et al.	5938667	Clip applier.
Green et al.	5573541	Stapler
Nardella	5207691	Electrosurgical clip applier




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts  
August 8, 2003

  
MICHAEL J. MILANO  
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